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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/020,248

12/18/2001

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EXAMINER

BEKERMANN, MICHAEL

ART UNIT

PAPER NUMBER

3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.		Applicant(s)	
	10/020,248		MATSUI ET AL.	
	Examiner		Art Unit	
	Michael Bekerman		3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/18/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I in the reply filed on 10/31/3006 is acknowledged. The traversal is on the ground(s) that claims 18 and 19 are related to the claims in Group I by incorporation and no undue burden would be imposed on Examiner. This is not found persuasive because Examiner believes claims 18 and 19 indeed represent an undue burden. The fact that inventions disclosed in 2 claims may be connected together is proof alone that there are 2 separate inventions useable together.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

2. **Claim 12 is objected to** under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Since a first user identifier is "user information relating to the user", claim 12 is not further storing anything different than claim 1.

3. **Claim 17 is objected to** because of the following informalities: There is a portion of text included after the claim right before claim 18 that beings with "As

recorded media herein". This text needs to be removed. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 3, 8, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claims 3 and 8, these claims recite the limitation "instead of the first user identifier". Limitations from parent claims can't be changed, only further limited. By using "instead of", applicant is replacing the user identifier of the parent claims, which makes the claim indefinite.

Regarding claim 16, this claim recites a computer program product. It is unclear as to what the differences are in this claim and claim 17.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claim 16 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Regarding claim 16, this claim appears to be merely programming instructions (or possibly merely data) per se and is not statutory. If the preamble set forth such data/programming being executed on a computer readable medium, then the claim would appear to be statutory. MPEP 2106 IV B 1 b.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1, 2, 10-13, and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Maritzen (U.S. Pub No. 2003/0220841).** Maritzen teaches merchant-to-merchant referral system that includes all of the limitations recited in the above claims.

Regarding claims 1, 2, 11, 12, and 15-17, Maritzen teaches a system that stores product information from different merchants for selection and purchase by a user (Paragraph 256). The user's identity is kept secret from merchants on the system by using an "identifier" (Paragraph 0034, Sentence 1 and Paragraph 48, Sentence 4). Once a product is selected for purchase, the system must inherently store the user identifier in relation to the product information (thus, assigning a correspondence). If the

merchant is unable to fulfill the product order, then a second merchant (and subsequently, the new referral represents a second product from different inventory) is referred to the user, and the second merchant is informed of the user's interest (Paragraph 0256).

Regarding claim 10, whenever a merchant can't fulfill an order, a referral is made and this is considered an iterative execution and when the order can be fulfilled, this ends the execution.

Regarding claim 13, the user identifier (user information) is reworked according to an inherently pre-set disclosure level (Paragraph 0048, Sentence 4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maritzen (U.S. Pub No. 2003/0220841).**

Regarding claim 9, Maritzen doesn't specify the ability for a merchant to update product information. Since Maritzen teaches the product information as being available on the system, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow merchants the ability to alter that information at a later date in case the product information changes.

Claims 3-8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maritzen (U.S. Pub No. 2003/0220841) in view of Herz (U.S. Patent No. 5,754,938).

Regarding claims 3 and 14, Maritzen teaches the user's identity as being kept secret from merchants on the system by using an "identifier" (Paragraph 0034, Sentence 1 and Paragraph 48, Sentence 4). Maritzen doesn't specify the identifier as varying for each merchant. Herz teaches the ability of a user to vary his information per merchant (Abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to create a different identifier for each merchant in the interest of keeping the user's dealings with merchants private.

Regarding claim 4, once a product is selected for purchase, the system must inherently store the user identifier in relation to the product information (thus, assigning a correspondence).

Regarding claim 5, Maritzen teaches a payment process as being carried out with the subsequent merchant (Paragraph 0256).

Regarding claims 6-8, should the second merchant of Maritzen not have a satisfactory product, the referral system would continue as in claims 1-3 for a third merchant. Thus, these claims would be rejected the under the same basis as those claims.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. ***

The following references are cited to further show the state of the art with respect to product referral systems:

U.S. Patent No. 6,356,879 to Aggarwal


U.S. Pub No. 2003/0018613 to Oytac

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MB



JEFFREY D. CARLSON
PRIMARY EXAMINER